

REMARKS

Claims 1-82 and 87-104 were cancelled in their entirety in an earlier filed amendment. Claims 113 and 114 are cancelled hereby. No additional amendments are presented at this time.

The rejection of claims 113 and 114 under 35 U.S.C. § 112 , first paragraph is now moot in light of the cancellation of these claims. Applicants do not acquiesce in the position taken in the presented rejection and reserve the right to pursue the subject matter of these claims at a later period in time. Claims 113 and 114 have been cancelled to facilitate the declaration of an interference between this application and U.S. Patent 6,333,700 B1 as requested on September 12, 2003.

The office action states that claims 83-86, 105-119, 121-134 and 136-138 conflict with some or all of the claims of co-pending Application No. 10/323,536 and indicates that a clear line of demarcation should be maintained between the two co-pending applications. Applicants do not agree that the claims conflict. There are no identical claims between the two applications. Applicants respectfully request reconsideration of this position in light of the fact that all of the claims in co-pending Application No. 10/323,536 require correlation to a well log. No such limitation is present in the pending claims of this application. This is a sufficient ground of demarcation between the claims in the two pending applications. Applicants suggest that if the examiner feels strongly that there is no patentable distinction between the applications, then Application No. 10/323,536 should be suspended until such time as the interference can be resolved. It will be apparent at that time what course of action would be appropriate dependent upon

the Final Judgment therein.

Claims 83-86, 105-119, 121-134 and 136-138 were rejected under the judicially-created doctrine of obviousness-type double patenting in view of the claims of co-pending Application No. 10/323,536. Accompanying this response is a Terminal Disclaimer that is effective to insure that the term of any patent that issues from this application will not extend beyond the term of any patent that might issue on co-pending Application No. 10/323,536 and that any such patent issuing from this application will remain enforceable only so long as co-ownership between any such issued patents is maintained. The filing of this Terminal Disclaimer removes the pending rejection. Applicants do not acquiesce to the examiner's position that the claims in these two applications constitute the same invention, nor that they would be obvious over each other. Applicants reserve the right to present a position of patentable distinction between these applications in future proceedings, including interference proceedings, which have been previously requested. This Terminal Disclaimer is filed to facilitate the removal of all pending rejections to enable the declaration of an interference between this application and U.S. Patent 6,333,700 B1 as requested on September 12, 2003.

Applicants appreciate the clarifications presented in the "Examiner's comments" section of the Office Action. It is noted, however, that contrary to the examiner's comments it is the Applicants' position that certain enumerated claims, specifically claims 117 and 129, are fully disclosed in application 09/286,650 and thus entitled to the April 6, 1999 filing date thereof.

Claim 117 further restricts claim 106 wherein but reciting that "the operation comprises a process selected from the group consisting of perforating processes, packer

setting processes, bridge plug setting processes, logging processes, inspection processes, chemical treating processes, casing patch processes, jet cutting processes and cleaning processes.”[emphasis added] As pointed out in Claim Chart A that is attached to both the Preliminary Amendment dated September 12, 2003 and the Request for Reconsideration dated January 20, 2004, U.S. patent application serial number 09/286,650, now U.S. Patent No. 6,333,699, discloses at column 13, line 55 – column 14, line 7 that “[t]he prior logging of the well hole characteristics ... into a database, provides an operator at the surface with all information necessary to determine the appropriate action to take and the appropriate positioning of the tool for perforating the casing or other operations in the pipe.” [emphasis added] The perforating process is described in greater detail at column 2, lines 26-42 of application 09/286,650. Perforating is also mentioned at column 9, lines 46-67. In view of this, it is submitted that claim 117 is supported by the disclosure of application 09/286,650 and entitled to the filing date thereof.

Claim 129 recites “[t]he system of claim 128 wherein said transport mechanism comprises a mechanism selected from the group consisting of wire lines, pumps, blowers, parachutes, coil tubing and tubing strings.” [emphasis added] As pointed out in Claim Chart A that is attached to both the Preliminary Amendment dated September 12, 2003 and the Request for Reconsideration dated January 20, 2004, U.S. patent application serial number 09/286,650, now U.S. Patent No. 6,333,699, discloses at column 9, lines 10-18 and 26-34, among other places, that “[t]he wireline 26 is shown extended from the conventional wireline head 34 (comprising a reel and/or other extension and retraction means for the wireline 26, and conventional means for communicating electrical power and signals to and from the wireline 26 and thus to the well tool 24 at the lower end

thereof) In many instances, the line 26 used to lower the tool 24 into the hole, and to withdraw the tool 24 from the hole, is a non-electric line.” In view of this, it is submitted that claim 129 is supported by the disclosure of application 09/286,650 and entitled to the filing date thereof.

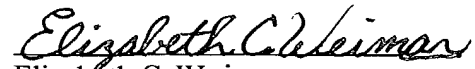
This amendment together with the accompanying Terminal Disclaimer is fully responsive to the Office action mailed August 26, 2004.

Applicants respectfully request entry and consideration of the previously filed request for interference in light of the amendment and remarks presented herein.

If the Examiner has any further questions relating to this reply or to the application in general, he is respectfully requested to contact the undersigned by telephone so that an indication of allowability and processing of the present application to declaration of an interference may be expedited.

Respectfully submitted,

DATE: November 24, 2004


Elizabeth C. Weimar
Reg. No. 44,475

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-3000